

REMARKS

I. Introduction

Claims 1 to 30 are pending in the present application. Claims 1 to 30 were rejected. Claims 14 and 24 were amended to improve clarity, rather than to reduce claim scope. The amendment is supported by the original disclosure and does not add new matter. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition. Applicant respectfully requests reconsideration of the present application.

II. Rejection of Claims 1-8, 25 and 28 under 35 U.S.C. § 103(a)

Claims 1-8, 25 and 28 were rejected under 35 U.S.C. § 103(a) over Schafer et al. (6,230,926) in view of Schick (2,049,140) and Roberts et al. (6,726,077). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Some embodiments of the Applicant's invention include ticket dispensers having a ticket bin whose position can be adjusted by selectively mounting the ticket bin in different positions; this feature allows lottery tickets of different sizes to be accommodated from a single dispenser with a single bin type. (*See, e.g.*, specification, page 9, line 18 to page 10, line 10.) Claim 1 recites, in relevant parts:

A lottery ticket dispenser for dispensing lottery tickets serially connected to each other along perforated joints, the dispenser comprising: a housing;

at least one drawer mounted within the housing;

at least one slot in the housing through which the tickets are dispensed;

and

at least one ticket bin adjustably mounted to each drawer, each ticket bin being adapted to contain at least one stack of the lottery tickets in a fan fold configuration, *the ticket bin being selectively mounted to the associated drawer in one of a plurality of positions to accommodate a variety of ticket stack sizes.* (emphasis added).

In support of the rejection, The Office Action stated:

Schafer discloses . . . a house, a plurality of ticket bins, a transparent panel, a bulkhead, a planar bottom, a pair of flanges, an angular wall, [sic] an arcuate guide Schafer et al. does not show a plurality of drawers and a slot. However, Schafer teaches the use of a plurality of drawers and for the purpose of displaying a plurality of different articles. . . . Regarding the slot, Roberts et al. teaches the use of slots for the purpose of issuing the tickets in strings.

(citations omitted). Applicant respectfully submits that the statement “Schafer teaches the use of a plurality of drawers [and] for the purpose of displaying a plurality of different articles” is erroneous. This sentence is at least partially contradicted by the immediately preceding sentence in the Office Action, which admits that Schafer does not show a plurality of drawers. A review of Schafer et al shows that Schafer et al neither teaches nor suggests drawers of any sort, let alone a plurality of drawers, and in fact does not even use the word “drawer” in its disclosure. Moreover, although Schafer et al generally mentions in passing that multiple bins could be used, it does not describe in any detail how a working arrangement of multiple dispensers would actually be implemented. Applicant respectfully submits that the Office Action may actually be intended to refer to “Schick” teaching “the use of a plurality of drawers” where a reference to Schafer was made. If the current explanation of the rejection is incorrect and the rejection is maintained, a corrected rejection is respectfully requested in the next Office communication.

Moreover, neither Schafer et al., Schick, nor Roberts et al. teach or suggest the recited feature of Applicant’s claim 1 – *“the ticket bin being selectively mounted to the associated drawer in one of a plurality of positions to accommodate a variety of ticket stack sizes.”* The Office Action has not identified where this feature is disclosed in either Schafer et al., Schick, or Roberts et al. Schafer et al. generally describes a dispensing apparatus for tickets of various sizes. Schafer et al., Abstract. However, Schafer et al. does not disclose the ticket bin being selectively mounted to the associated drawer in one of a plurality of positions to accommodate a variety of ticket stack sizes. Rather, Schafer et al. merely describes a tear bar bin assembly and the tickets being counted by programming the length of the lottery tickets

into the microcontroller. Schafer et al., column 5, lines 59-60. In fact, an inspection of Schafer et al, in particular Fig. 2, suggests that Schafer et al's ticket bin is oversized, with undersized tickets loosely located within the bin. In contrast, Applicant's claimed invention has the advantage of a bin which is selectively mountable at a variety of positions, which can be adjusted to reflect the size of the tickets dispensed.

Even if Schafer et al's bin were positioned in the drawers of Schick, as suggested in the nothing teaches suggests that a plurality of mounting positions should be provided within Schick's drawers that are chosen to accommodate tickets of different sizes. The Office Action comments "Schafer et al. is capable of being in any position inside the drawer". Even if this statement, which is not necessarily agreed with by Applicant, were arguably true, neither Schafer nor Schick teaches or suggests selectively mounting the Schafer's bin at different ones of a plurality of available positions to accommodate changes in ticket size. Since the proposed combination does not teach each and every feature of Applicant's claim 1, the Office Action has failed to put forward a *prima facie* case of obviousness. Accordingly, for at least this reason, Applicant respectfully submits that the rejection should be withdrawn.

Applicant also respectfully traverses the proposed combination of Schick and Schafer et al. The Office Action states that Schafer et al. should be modified by providing the plurality of drawers as taught by Schick "in order to obtain a device that display [sic] a plurality of different articles". However, Schafer et al. already describes that his bins can be mounted side by side, to display multiple tickets. The Office Action simply relies on Applicant's claim as a map to propose the combination of Schick and Schafer et al. There is no specific teaching in the art that would teach or suggest the particular combination of Schick and Schafer et al. in the way put forward in the Office Action. In particular, there is absolutely no teaching or suggestion of any particular approach to selectively mounting Schafer et al's bin in Schick's drawer at a variety of positions to accommodate tickets of different length, as recited in Applicant's claim 1. Thus, Applicant respectfully submits that the proposed combination is an improper hindsight reconstruction and should be withdrawn.

Moreover, Schick specifically teaches away from the proposed combination. In Schick, by design, the actual product held in the drawers is not visible to the customer. Rather, products stored in Schick are hidden in a closed container "thus insuring their being kept in a state of perfect preservation". Schick at 2:19-29. Schick teaches that this approach prevents "the loss which results when the articles themselves are employed to display the stored stock". As can be seen in Schick Fig. 1, Schick's display board 30 completely hides

from the consumer the drawers holding stock. *Id.* In contrast, Schafer et al. is expressly designed with a transparent bin to allow the customer to see the stock. See, e.g., Schafer et al. at 3:25-35. Thus, since Schick teaches inventory should be hidden, while Schafer et al. teaches inventory should be made visible to the consumer, both references teach away from the proposed combination. For this additional reason, Applicant submits that the proposed combination does not render Applicant's claim 1 obvious.

Claims 2-8, 25 and 28 depend from independent claim 1 and therefore should be allowable for at least the same reasons as those given above for claim 1. Separately and independently, claim 25 recites "when the ticket bin is selectively mounted in different ones of the plurality of positions, the arcuate guide is configured to be at different respective distances from the at least one slot". This feature is not found in the cited references or identified in the Office Action.

III. Rejection of Claims 9 and 10 under 35 U.S.C. § 103(a)

Claims 9-10 stand rejected under 35 U.S.C. 103(a) over Schafer et al. (6,230,926) in view of Schick (2,049,140) and Roberts et al. (6,726,077) as applied to claim 1 and further in view of Burr (5,222,624). Applicant traverses the rejection and respectfully submits that claims 9-10 are not obvious in light of the proposed combination of references.

Claims 9-10 depend from claim 1, and therefore should be allowable for at least the same reasons as those given above for claim 1.

Separately and independently, Applicant also respectfully traverses the proposed combination with Burr '624. The Office Action says that an ordinary artisan would make this combination "in order to obtain a device that automatically dispenses tickets". However, Schafer et al. expressly teaches away from this proposed combination, denigrating the Burr '624 device as too expensive, and indicating that his device is expressly not to work like the device described in the Burr '624 patent. *See* Schafer et al. at 1:41-52. Accordingly, an ordinary artisan considering the Schafer et al. reference would have expressly been lead away from the proposed combination with Burr '624. For at least this additional reason, Applicant submits that claims 9 and 10 are not obvious, and requests the rejection be withdrawn.

IV. Rejection of Claims 13-16, 19-22, 26-27 and 29-30 under 35 U.S.C. § 103(a)

Claims 13-16, 19-22, 26-27, and 29-30 stand rejected under 35 U.S.C. 103(a) over Schafer et al. (6,230,926) in view of Schick (2,049,140) and Roberts et al. (6,726,077) and Burr (5,222,624). Applicant traverses the rejection and respectfully submits that claims 13-16, 19-22, 26-27, and 29-30 are not obvious in light of the proposed combination of references.

Independent Claim 13 recites that ticket bin which is “selectively mounted to the associated drawer in one of a plurality of positions to accommodate a variety of ticket stack sizes” and therefore should be allowable for at least similar reasons to those discussed above for claim 1. The proposed combination with Burr ‘624 is also traversed for reasons similar to those given above for claims 9 and 10.

Claims 14-16, 26, and 29 depend from claim 13 and therefore should be allowable for at least the same reasons as those given above for claim 13.

Independent Claim 19 recites a ticket bin which is “selectively mounted to the associated drawer in one of a plurality of positions to accommodate a variety of ticket stack sizes” and therefore should be allowable for at least similar reasons to those discussed above for claim 1. The proposed combination with Burr ‘624 is also traversed for reasons similar to those given above for claims 9 and 10.

Claims 20-22, 27, and 30 depend from claim 19 and therefore should be allowable for at least the same reasons as those given above for claim 19.

Separately and independently, claims 26 and 27 recite “when the ticket bin is selectively mounted in different ones of the plurality of positions, the arcuate guide is configured to be at different respective distances from the at least one slot”. This feature is not taught or suggested in the cited references, and has not been identified in the present Office Action. These claims should be allowable for at least this additional reason.

V. Rejection of Claims 11-12 under 35 U.S.C. § 103(a)

Claims 11-12 stand were rejected under 35 U.S.C. 103(a) over Schafer et al. (6,230,926) in view of Schick (2,049,140) and Roberts et al. (6,726,077) and further in view of Osawa (6,527,129). Applicant traverses the rejection and respectfully submits that claims 11-12 are not obvious in light of the proposed combination of references.

Claims 11 and 12 depend from claim 1 and therefore should be allowable for at least the same reasons as those given above for claim 1. The proposed combination with Burr '624 is also traversed for reasons similar to those given above for claims 9 and 10. Moreover, Applicant respectfully traverses the proposed combination of Osawa with the other references. This five-way combination, which picks and chooses features from the cited art using Applicant's claimed invention as map, does not make out a proper *prima facie* case of obviousness. The Office Action says the socket and tabs as allegedly taught by Osawa would be added "to obtain a device that quickly attaching [sic] different size products". But the tickets (i.e., "the products") are not attached to the machine in either Applicant's claimed machine or in the other cited references. Accordingly, an ordinary artisan would not be lead to make the proposed combination with Osawa, which generally describes a set of racks for product displays. Nothing in Osawa even remotely teaches or suggests putting a socket and tab mechanism *inside a drawer* to allow selective positioning of a ticket bin to accommodate tickets of different sizes. Accordingly, Applicant submits that claims 11 and 12 are not obvious in light of the proposed combination, and respectfully requests that the rejection be withdrawn.

VI. Rejection of Claims 17-18 and 23-24 under 35 U.S.C. § 103(a)

Claims 17-18 and 23-24 were rejected under 35 U.S.C. § 103(a) over Schafer et al. (6,230,926) in view of Schick (2,049,140), Roberts et al. (6,726,077), and Burr (5,222,624) and further in view of Osawa (6,527,129).

Claims 17 and 18 depend from independent claim 13 and therefore should be allowable for at least the same reasons as those given above for claim 13. Claims 23 and 24 depend from independent claim 19 and therefore should be allowable for at least the same reasons as those given above for claim 19. Moreover, the proposed combination with Osawa is traversed for at least reasons similar to those given above with respect to claims 11 and 12.

VII. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited. While no fee is believed to be required, the Office is authorized to charge any fee arising in connection with this paper to the deposit account of Kenyon & Kenyon LLP, No. 11-0600.

Respectfully submitted,

KENYON & KENYON LLP

Dated: Feb. 13, 2007 By:



Andrew Reibman
Reg. No. 47,893
One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646